

REMARKS

Claims 1-34 were pending and presented for examination and in this application. In an Office action dated September 1, 2005, Examiner indicates that claims 13-19, 26, 27, 29, and 31-34 were withdrawn and claims 1-12, 20-25, 28 and 30 were rejected. Applicants thank Examiner for examination of the claims pending in this application and addresses Examiner's comments below.

Applicants begin by noting that claims 13-19, 26, 27, 29, and 31-34 were previously canceled without prejudice in Applicants' Amendment A. Hence, these claims are incorrectly noted as being "withdrawn." Applicants will presume Examiner meant to indicate that the claims were "canceled" unless otherwise noted in the next Office communication with Applicants. In addition, Applicants note they have amended claims 7 through 10 to recite more particular structural language as further described below.

Response to Rejection Under 35 USC 103(a) in View of Haraguchi and Zirul

In the 1st paragraph of the Office action, Examiner rejects claims 1-8, 11, 12 and 20-23 under 35 USC § 103(a) as allegedly being unpatentable in view of U.S. Patent No. 6,813,416 to Haraguchi ("Haraguchi") and U.S. Patent No. 6,912,399 to Zirul ("Zirul"). This rejection is respectfully traversed.

Claim 1 recites, inter alia, a mobile device that includes:

...
a user-controllable pivoting input switch having multiple operational modes, wherein a plurality of operational modes direct the operation of the mobile computing application, and a plurality of operational modes direct the operation of the phone application.

In addition, claim 20 recites, inter alia, a mobile device that includes:

...
a user-controllable pivoting input switch that can be operated in at least first and second operational modes, wherein each operational mode directs the operation of the computing and phone applications, wherein the first operational mode requires the switch to pivot in one direction about an axis, and the second operational mode requires the switch to pivot in another direction about the axis;

wherein while the phone application is active, the first and second operational modes direct the phone application to adjust the volume of a phone conversation during an active call session.

Further, claim 21 recites a method of operating a mobile device that has a pivoting input switch, a computing application, and a phone application, the method including:

rotating the switch in a first direction to direct the phone application to perform a first operation; and

rotating the switch in the first direction to direct the computing application to perform a second operation.

The claimed features in claims 1 and 20 beneficially include a pivoting input switch having a multiple operational modes that direct operation of a mobile computing application and operation of a phone application, which are within the same device. In addition, claims 20 and 21 also beneficially disclose pivoting among two different axis (e.g., x-axis and y-axis). By way of example, one claimed aspect of this configuration, as recited in claim 20, is that either axis can be used to control volume in an active phone conversation.

The cited references, Haraguchi and Zirul, either alone or in combination, fail to disclose the claimed invention. Haraguchi discloses a pager with a jog dial 17 that is functional for the operational mode of a mobile computing application and nothing more. (See Haraguchi, col. 5, lines 31-47; Fig. 1) Thus, Examiner is correct that Haraguchi fails to disclose a phone application on the same device and use of a user-controllable pivoting input

switch having an operational mode for the phone application separate from the mobile computing application.

Examiner's reliance, however, on Zirul fails to correct the deficiency of Haraguchi. Zirul is a mobile telephone that includes preset numbers and messages to appropriately restrict use of the mobile telephone. (See Zirul, Abstract). There is no disclosure in Zirul of a mobile computing application separate from a mobile phone application. Rather, Zirul is simply a mobile telephone 100 that is pre-programmed. The functions and preprogrammed numbers and messages are selected through "talk button 60", "end button 70", and "operational buttons 40". (See Zirul, col. 4, line 9 to col. 6, line 45; Fig. 1). The only reference to a dial is at col. 6, line 44, in conjunction with well known volume control, such as those found on conventional transistor radios. That is not what is being claimed.

The claimed invention recites a mobile computing device having at least a mobile computing application and a telephone application. Zirul clearly lacks both applications and instead only has a dedicated telephone with restricted functionality. Further, because it lacks the two different applications it also fails to disclose the "user-controllable pivoting input switch having multiple operational modes" of which "a plurality of operational modes direct the operation of the mobile computing application, and a plurality of operational modes direct the operation of the phone application" of claim 1. Likewise, because it lacks two different applications as recited in claim 20 it also lacks a method that rotates "the switch in a first direction to direct the phone application to perform a first operation" and rotates "the switch in the first direction to direct the computing application to perform a second operation."

Moreover, both Haraguchi and Zirul fail to disclose “wherein the first operational mode requires the switch to pivot in one direction about an axis, and the second operational mode requires the switch to pivot in another direction about the axis” as recited in claim 20. The jog dial 17 in Haraguchi “serves as the up-down key as described later by rotating the dial knob, and also serves as a non-lock type press button by pressing the job dial in a radial direction.” (See Haraguchi, col. 5, lines 38-41). However, rotating up and down and pressing a button is not pivoting in two separate directions as is claimed. (Zirul, col. 6, lines 43-44). In addition, Zirul only discloses a conventional radio type volume dial, which rotates up or down. Again, this is not pivoting along two separate axis as is claimed.

Nor is there any motivation, teaching, or suggestion to combine Haraguchi and Zirul. It is well settled law that when making a rejection under 35 U.S.C. § 103, Examiner has the burden of establishing a prima facie case of obviousness. Examiner can satisfy this burden “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references” in the manner suggested by Examiner. (In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)). “[E]lements of separate prior patents [and/or publications] cannot be combined when there is no suggestion of such combination anywhere in those patents [and/or publications]...; and a court should avoid hindsight...” (emphasis added; annotations within square brackets). (Panduit Corp. v. Dennison Mfg. Co., 1 USPQ2d 1593, 1597 (Fed. Cir. 1987)). In the present case, Applicants’ claims, which recite particular arrangements of a user-controllable pivoting which for multiple modes of operation, including a mobile computing application and a phone application on a mobile device, may be especially susceptible to impermissible obviousness rejections.

The Examiner's rejection has attempted to achieve Applicants' claimed configuration by picking and choosing certain spatial relationships of components as shown in the different references, and then rearranging those components piecemeal until something resembling the claimed arrangement was found. This is the essence of a hindsight rejection. There is no apparent motivation for any of the suggested modifications other than to achieve the claimed invention — i.e., to use the claims themselves as a roadmap for invalidating them. The claimed arrangement of the mobile device achieves a certain benefit, as described above and in the specification. None of the references even hint at a motivation for rearranging their components to achieve the resulting benefit of the claimed invention. No obviousness rejection can stand under these or any other references without a coherent theory as to why one of skill in the art would have been motivated to rearrange the components of one reference based on the disclosure of the other references. Here, there is no such motivation outside the present application itself. Thus, the basis for the rejection to claims 1, 20, and 21 should be withdrawn.

Likewise, dependent claims 2 through 8 and 12, which depend from claim 1, and claims 22 through 23, which depend from claim 21, are also distinguishable over the cited references. Thus, for at least the reasons set forth above, Applicants respectfully submit that the rejection of claims 1 through 12 and 20 through 23 should be withdrawn. Applicants also submit that these claims are now in condition for allowance.

Response to Rejection Under 35 USC 103(a) in View of

Haraguchi, Zirul and Silverbrook

In the 2nd paragraph of the Office action, Examiner rejects claims 9-10 under 35 USC § 103(a) as allegedly being unpatentable in view of Haraguchi, Zirul and U.S. Patent No. 6,788,293 to Silverbrook (“Silverbrook”). This rejection is respectfully traversed.

In this section of the Office action, Examiner merely recites Applicants claim language and then in support notes:

as evidenced by the claims, it would have been obvious for one of ordinary skill in the art at the time of the invention to construct the device such that the switch is operable to perform any variety of functions, since doing so would not in any way affect the functionality or proper operation of the device.

Examiner provides no support from the cited references as to patentability. Nevertheless, Applicants have amended claims 9 and 10, along with the claim from which they depend, claim 8, to recite particular structural language. Specifically, the claims now recite the a positional configuration that includes “the switch is structured to maintain a depressed and held position.” As now amended, these claims are patentably distinguishable over the cited references. Applicants request withdrawal of the rejection and allowance of these claims.

Response to Rejection Under 35 USC 103(a) in View of

Richards, Nuovo and Hikishima

In the 3rd paragraph of the Office Action, Examiner rejects claims 24, 25, 28 and 30 under 35 USC § 103(a) as allegedly being unpatentable in view of U.S. Patent No. 5,141,540 to Richards (“Richards”), U.S. Patent No. 6,097,964 to (Nuovo et al.) (“Nuovo”)¹, and U.S.

¹ Examiner’s Office action refers to claims 24, 25, 28, and 30 as being rejected under 35 USC § 103(a) in view of Richards, Haraguchi, and Hikishima. However, the actual rejection never references Haraguchi,

Patent Publication No. US 2003/0045245 A1 to Hikishima ("Hikishima"). This rejection is respectfully traversed.

Claim 24 recites, inter alia, a mobile device that comprises:

- a display screen,
- a lid removably covering the display screen, said lid having a transparent element that allows at least a portion of the display screen to be visible while the lid covers the display screen;
- a phone application;
- a headset socket; and
- a user-controllable pivoting input switch that directs the operation of the application while the lid covers the display screen, wherein the pivoting input switch allows a user to interact with the phone application while the lid covers the display screen only when an earpiece or headset is plugged into the headset socket.

The claimed invention beneficially includes a pivoting input switch that allows a user to interact with the phone application while the lid covers the display screen only when an earpiece is plugged into the headset socket. Examiner's rejection, which includes a new cited reference, Hikishima, cannot stand because Hikishima is improper reference art for this rejection. (See 35 USC § 102(e); MPEP 2136.03). Thus, Applicants request the rejection to claim 24, and its dependent claims 25, 28, and 30, be withdrawn. In addition, Applicants also respectfully request allowance of these claims at this time.

Conclusion

In sum, Applicants respectfully submit that claims 1-12, 20-25, 28 and 30, as presented herein, are patentably distinguishable over the cited references (including

but rather Nuovo. Hence, Applicants assume that Examiner intended Nuovo unless otherwise indicated in a subsequent paper from the Office.

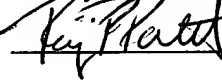
references cited, but not applied). Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite Examiner to contact Applicants' representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

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By: _____

Respectfully Submitted,
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